



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/828,970 | 04/10/2001 | Hsien-Tsung Yeh | MR1111-623 | 7132 |
| 4586 | 7590 | 04/15/2004 | EXAMINER | |
| ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043 | | | LEE, EDMUND H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1732 | |

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,970

Applicant(s)

YEH, HSIEN-TSUNG

Examiner

EDMUND H. LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims introduce new matter into the disclosure. The added material which is not supported by the original disclosure is as follows:

the word "capturing" (cl 1, ln 3) lacks support in the instant specification. There is no mention of the word or the concept of capturing in the instant specification.

the phrase "capturing and rolling...said inner cup surface" (cl 1, lns 3-5) lacks support in the instant specification. The breadth and scope of the phrase is not supported. The instant specification only discloses using a thermal-withstanding silicon rubber roller. See page 4 of the instant specification.

the phrase "said 3D-image...said inner cup surface" (cl 1, lns 4-5) lacks support in the instant specification. The instant disclosure discloses transferring the image layer bearing the 3D-image to the inner cup. There is no support for transferring the 3D-image apart from the image layer bearing the 3D-image. The above phrase is broad enough to include transfer printing however, such is not supported by the instant specification.

the phrase "capturing and rolling...said 3D-image" (cl 1, lns 6-10) lacks support in the instant specification. The breadth and scope of the phrase is not supported. The

Art Unit: 1732

instant specification only discloses using the thermal-withstanding silicon rubber roller used to transfer the image layer bearing the 3D image to the surface of the inner cup.

See page 4 of the instant specification.

the word "capturing" (cl 1, ln 6) lacks support in the instant specification. There is no mention of the word or the concept of capturing in the instant specification.

the word "capturing" (cl 2, ln 1) lacks support in the instant specification. There is no mention of the word or the concept of capturing in the instant specification.

2. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said 3D-image" (cl 1, lns 4, 7, 10 and 12) lacks antecedent basis in the claim. There is basis for --said image layer bearing the 3D image--.

The phrase "said image" (cl 1, lns 4, 7, 10 and 12) lacks antecedent basis in the claim. There is basis for --said image layer bearing the 3D image--.

Clarification and/or correction is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in the instant specification at pgs 1-2 and figs 14-17 in view of Yamaguchi et al (USPN 5200253) and Holbrook et al (USPN 4332635). In

regard to claim 1, the admitted prior art teaches the basic claimed process including an injection encapsulating process (pgs 1-2; figs 14-17); transferring a layer of 3D-animation to an inner cup (pgs 1-2; figs 14-17); transferring a layer of varnish over the layer of 3D-animation on the inner cup (pgs 1-2; figs 14-17); transferring the inner cup with the varnish and layer of 3D-animation thereon to an injection mold (pgs 1-2; figs 14-17); and injection molding around the inner cup in order to encapsulate the varnish, layer of 3D-animation, and inner cup (pgs 1-2; figs 14-17). The admitted prior art also teaches that the varnish protection layer does not protect the 3D-animation from subsequent processing such as encapsulation by injection molding (pgs 1-2, figs 14-17). However, the admitted prior art does not teach capturing and rolling directly against a surface of the inner cup the image layer bearing the 3D image; using the thermal-withstanding protection layer; and capturing and rolling the thermal protection layer against the exterior of the 3D image on the inner cup surface. In regard to capturing and rolling the image layer and the protection layer, Holbrook et al teach using an apparatus including a roller to apply labels onto an outer surface of a cup wherein the labels are decorative (fig 1). The admitted prior art and Holbrook et al are combinable because they are analogous with respect to applying a decorative layer to an exterior surface of a cup. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the apparatus of Holbrook et al to transfer the image layer and protection layer of the admitted prior art. In regard to using a thermal-withstanding protection layer, Yamaguchi et al teaches hologram forming sheets having a protective layer or varnish over the hologram (col 18, lns 8-14); and

using a protective layer of poly (vinyl chloride-co-vinyl acetate) material if printing or other processing is to be done on the surface of the protective layer (col 18, lns 8-14)-- as a note, the poly (vinyl chloride-co-vinyl acetate) protection layer constitutes a thermal-withstanding protection layer. The admitted prior art and Yamaguchi et al are combinable because they are analogous with respect to protecting 3D-animation with a protection layer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the poly (vinyl chloride-co-vinyl acetate) protection layer of Yamaguchi et al in place of the varnish of the admitted prior art in order to protect the 3D-animation from the subsequent step of encapsulating by injection molding of the admitted prior art. In regard to claim 2, the admitted prior art does not teach using a thermally protected silicone rubber roll member. The use of a specific type of roll member is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, silicon rollers are well-known in the molding art for their releasability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermally protected silicon rubber roll member in the apparatus of the admitted prior art (modified) in order to ensure efficient and proper transfer of the image layer and protection layer.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. STROHMEYER ET AL (USPN 5833803) teach using a silicon rubber roller in a labeling apparatus in order to prevent jamming and sticking. Haugk et al (USPN 5937554) teach the use of thermal-withstanding protection layers to protect 3D-animations.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

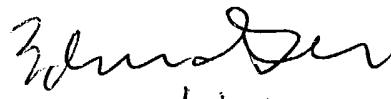
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EHL

EDMUND H. LEE
Primary Examiner
Art Unit 1732



4/6/04